

IN THE DRAWINGS:

Twelve (12) sheets of formal drawings are enclosed. These drawings replace the previously filed drawings. FIGS. 18 and 19 are new. No new matter has been added.

REMARKS

Claims 19-26 and 45-50 are pending and stand rejected. Claims 19, 23, 45, 48 and 49 are amended. Claims 19-26 and 45-50 are pending upon entry of this amendment.

Summary of the Office Action

1. The drawings are objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.
2. Claim 23 is objected to because of informalities.
3. Claims 48 and 49 stand rejected under 35 U.S.C. §112, second paragraph.
4. Claims 19-26 and 45-50 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement.
5. Claims 22 and 23 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement.
6. Claims 19-21 and 24-26 are rejected under 35 U.S.C. §102(e) as being anticipated by Lipponent et al. (U.S. Patent No. 7,412,258 B1), hereinafter Lipponent.
7. Claims 45-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lipponent, and further in view of Kulp (U.S. Patent No. 4,803,474).

These rejections are now traversed.

Objection to Drawings

A complete set of formal drawings is enclosed. These drawings replace the previously filed drawings. FIGS. 18 and 19 are new, and address this objection. No new matter is added. The Examiner is requested to withdraw the objection to the drawings.

Claim Objections

Claim 23 is amended as suggested by the Examiner.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 48 and 49 are amended as suggested by the Examiner. Amended claims 48 and 49 have sufficient antecedent basis for each of the claimed limitations. The Examiner is requested to withdraw this rejection.

Written Description Rejections – 35 U.S.C. §112, First Paragraph

Claims 19-26 and 45-50 comply with the written description requirement. The rejection should be withdrawn because the applicable legal standard is met by the claims and the specification. The Examiner is directed to MPEP 2163.04:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. (emphasis is added by Applicant)

...

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.) (emphasis is added by Applicant)

The Examiner has failed to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure in the application as filed. For this reason alone, the Examiner does not have a reasonable basis to challenge the adequacy of the written description, and the written description rejections of Claims 19-26 and 45-50 should be withdrawn.

The rejections of Claims 19-26 and 45-50 are deficient for additional reasons discussed below.

Claim 19

The Examiner rejects Claim 19 based on three separate groups of limitations (referred to herein as “Group 1,” “Group 2” and “Group 3”). Each Group is discussed below.

Group 1

Claim 19 is rejected for reciting “a display assembly accessible on a front surface of the first segment” (herein, “Group 1”).

To satisfy the written description requirement, the originally filed specification should reasonably convey to a person having ordinary skill that the Applicant had possession of the claimed subject matter. *Ex parte Sorenson* 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987). Based on the established law, this rejection must be withdrawn. There is ample support for Group 1 in the specification. The following quotations from the specification are examples of support for Group 1:

From page 6 of the specification:

In one embodiment, a first segment is movably connected to a second segment. The first segment includes a contact-sensitive display. The second segment includes an input mechanism. The first segment and second segment can be moved between a contracted position and an extended position. In the contracted position, the second segment is overlaid relative to the first segment so that a portion of the display assembly is not accessible. In the extended position, the second segment is moved away from the display assembly so that all of the display assembly is accessible to a user of the handheld computer.

From page 8 of the specification:

A front surface 112 of first segment 110 provides access to a contact-sensitive display assembly 125. The display assembly 125 may include an immediate character recognition region 128, and an output region 126. A front panel 122 of second segment 120 provides a plurality of actuatable mechanisms.

Group 2

Claim 19 is further rejected for reciting “a second segment slideably coupled to the first segment . . . from the extended position” (herein, “Group 2”). Group 2 is supported in the specification. The following quotations from the specification are examples of support for Group 2:

From page 6 of the specification:

In another embodiment, a second segment is slideably coupled to the first segment. The second segment can be positioned relative to the first segment to overlay and reduce an area of the contact-sensitive display assembly.

Moveable refers to movement in one or more directions, including rotations, and combinations of motions. Slideable means movement primarily in one direction.

From page 8 of the specification:

The first segment 110 and/or the second segment 120 may be moved along an axis to affect a size of the handheld computer. The movement by the first segment 110 and/or the second segment 120 may be linear. In one embodiment, one segment slides relative to another segment to affect the size of handheld computer 100.

From page 21 of the specification:

F.....Alternative Embodiments

Embodiments described herein have provided for first segment 110 to include a display assembly, and second segment 120 to include input mechanisms. The relationship between the second segment 120 and first segment 110 has included configurations where second segment 120 has been positioned to overlay first segment 110. Other embodiments, however, may provide for the relationship between first segment 110 and second segment 120 to be reversed. For example, first segment 110 may be moved so that a display surface overlies the buttons. The second segment 120 may provide for the display assembly, while first segment 110 provides for input mechanisms. Other examples and configurations are also contemplated by embodiments of the invention.

While embodiments described above provide for housing segments to reduce a length of handheld computer 100, other embodiments may provide for a similar configuration to be used for a width of handheld computer 100, where lateral sides 105, 105 can be moved closer to or further away from each other by first segment 110 and second segment 120.

Group 3

Claim 19 is further rejected for reciting “a Group of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the extended position and not when in the contracted position” (herein, “Group 3”). Group 3 is supported in the specification. The following quotations from the specification are examples of support for Group 3:

From page 6 of the specification:

In one embodiment, a first segment is moveably connected to a second segment. The first segment includes a contact-sensitive display. The second segment includes an input mechanism. The first segment and second segment can be moved between a contracted position and an extended position. In the contracted position, the second segment is overlaid relative to the first segment so that a portion of the display assembly is not accessible. In the extended position, the second segment is moved away from the display assembly so that all of the display assembly is accessible to a user of the handheld computer.

From page 17 of the specification:

The immediate character recognition region 128 of display assembly 125 may correspond to the location of reduced section 118 of first segment 110. Therefore, when second segment 120 is moved into the contracted position, second segment 120 is positioned over immediate character recognition region 128. The contracted position of handheld computer 100 may correspond to a selected mode where character entry is not possible. However, since input mechanisms 132 (FIG. 1) and multi-directional member 134 (FIG. 1) are accessible, data may be selected and displayed when handheld computer 100 is in the contracted position.

Based on the forgoing, the written description rejection for Claim 19 should be withdrawn because each of the claimed limitations is supported in the specification. Claims 20-26 are rejected for depending from Claim 19, shown above to be supported in the specification. Accordingly, to the extent that Claims 20-26 are rejected because of their dependency on Claim 19, the written description rejections for these claims should be withdrawn.

Claims 20-26 are rejected for additional reasons. These reasons are discussed below.

Claim 21

Claim 21 is further rejected for reciting “wherein all of the display assembly is accessible to receive contact as input when the second segment is in the extended position” (herein, “Group 4”). Group 4 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3.

The written description rejection of Claim 21 should be withdrawn.

Claim 22

Claim 22 is further rejected for reciting “the display assembly includes an immediate character recognition section configured to immediately recognize and display a character entry, and wherein a portion of the display assembly that is overlaid by the first segment includes the immediate character recognition section” (herein, “Group 5”).

Group 5 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Group 5 is also supported by Claim 3 of the originally filed application.

The written description rejection of Claim 22 should be withdrawn.

Claim 23

Claim 23 is further rejected for reciting “the display assembly includes a first section having a cross-section comprising a digitizer pad and a screen, and a second section comprising the digitizer pad without the screen, and wherein a portion of the display assembly that is overlaid by the first housing segment includes the second section.” (herein, “Group 6”). Group 6 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Group 6 is also supported by Claim 23 of the originally filed application.

The written description rejection of Claim 23 should be withdrawn..

Claim 24

Claim 24 is further rejected for reciting “a midframe coupled to the first segment and the second segment.” (herein, “Group 7”). Group 7 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Group 7 is also supported by Claim 24 of the originally filed application.

The written description rejection of Claim 24 should be withdrawn.

Claim 25

Claim 25 is further rejected for reciting “the midframe includes a first rail . . .” (herein, “Group 8”). Group 8 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Group 8 is also supported by Claim 25 of the originally filed application.

The written description rejection of Claim 25 should be withdrawn.

Claim 26

Claim 26 is further rejected for reciting “the midframe includes a first rail and a

second rail. . .” (herein, “Group 9”). Group 9 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Claim 26 is also supported by Claim 26 of the originally filed application.

The written description rejection of Claim 26 should be withdrawn.

Claim 45

The Examiner rejects Claim 45 based on three separate sets of limitations (referred to herein as “Group 10,” “Group 11” and “Group 12”). Each Group is discussed below.

Group 10 and Group 11

Claim 45 is rejected for reciting “a second segment movably coupled to . . . in the extended position” (herein, “Group 10”) and “a display assembly provided by the first segment” (“Group 11”). Group 10 and Group 11 are supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3.

Group 12

Claim 45 is further rejected for reciting “a Group of one or more input mechanisms provided on the second segment . . .” (herein, “Group 12”). Group 12 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3. Group 12 is also supported by the following quotation from pages 9 and 10 of the specification:

The actuable mechanisms provided on front panel 122 of second segment 120 include a combination of actuation mechanisms 132, as well as a multi-directional component 134. The actuation mechanisms 132 are mechanisms that have one of two states- actuated and not actuated. The multi-directional component 134 has multiple states-one state for each direction it can be actuated in, and a non-actuated state. The multi-directional component 134 may also have a center actuation state, corresponding to being centrally contacted or pressed straight down. The actuable mechanisms 132 and/or multi-directional

component 134 may be formed from buttons, contact-sensitive surfaces, or other mechanical switches.

Based on the forgoing, the written description rejection for Claim 45 should be withdrawn because each of the claimed limitations is supported in the specification. Claims 46-50 are rejected for depending from Claim 45, shown above to be supported in the specification. Accordingly, to the extent that Claims 46-50 are rejected because of their dependency on Claim 45, the written description rejections for these should be withdrawn.

Claims 47, 49 and 50 are rejected for additional reasons. These reasons are discussed below.

Claim 47

Claim 47 is further rejected for reciting “the multi-directional mechanism includes a Group of one or more buttons” (herein, “Group 13”). Group 13 is supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3 and 12. Group 13 is also supported by Claim 43 of the originally filed application.

The written description rejection of Claim 47 should be withdrawn.

Claims 49 and 50

Claim 49 is further rejected for reciting “the first segment overlays the second segment so that the display assembly covers at least a portion of the first input mechanism” (herein, “Group 14”). Claims 50 is further rejected for reciting “the second segment is configured to slide towards and away from the first segment” (herein, “Group 15”). Sets 14 and 15 are supported throughout the specification, including, for example, the various different quotations discussed above for Groups 1-3 and 12.

The written description rejections of Claims 49 and 50 should be withdrawn.

General Deficiencies in the Written Description Rejections

Applicant notes that written description rejections rely heavily on the following assertion:

Note that the invention of independent claim 19 or claim 45 is directed to an embodiment of a handheld computer (i.e., the claimed mobile device) comprising a housing assembly that is adjustable to affect a width of the handheld computer. The original disclosure, when filed, merely discloses a SINGLE paragraph (see the specification, page 21, last paragraph) regarding to the embodiment capable of varying a width of the handheld computer:

"While embodiments described above provide for forming a separate or integral length of handheld computer 100, other embodiments MAY provide for a similar configuration to be used for a width of handheld computer 100, which, however, may vary, for example, longer up or further away from each other by first segment 110 and second segment 120," (emphasis added).

The above mentioned disclosure does not explicitly disclose what embodiments may provide or may not provide for a similar configuration to be used for a variation in a width of a handheld computer. In other words, the above mentioned disclosure does not explicitly disclose

The Examiner is arguing that certain limitations in Claims 19 and 45 are supported by a single paragraph in the specification (page 21, lines 19-22), and thus, not adequately described in the specification. Respectfully, this is incorrect. There is no requirement that the claims be supported by more than one paragraph; **all that matters is that the specification describes the claims in sufficient detail that a person having ordinary skill in the art recognize that inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.** See MPEP 2163. Even assuming that the above-quoted limitations of Claim 19 were supported by only one paragraph, in this case, this is sufficient to meet the requirements of §112. Furthermore, as shown above, the limitations at issue are supported by numerous portions in the specification. The Examiner's assertion that these limitations are supported by a single paragraph is incorrect.

Applicant also notes that the Examiner asserts throughout the Office Action that the features described in the specification between page 1 and page 21, line 18 cannot be used to show support for Claims 19-26 and 45-50. The Examiner's logic appears to be that Claims 19-26 and 45-50 are directed to an embodiment described at page 21, lines 19-22 of the specification, and thus, features not explicitly disclosed at page 21, lines 19-22 cannot be recited by the claims. Respectfully, this is incorrect. The explicit language

of the specification makes clear that embodiment optionally includes features disclosed in the preceding pages of the specification. The Examiner is directed to page 21 of the specification:

While embodiments described above provide for housing segments to reduce a length of handheld computer 100, other embodiments may provide for a similar configuration to be used for a width of handheld computer 100, where lateral sides 105, 105 can be moved closer to or further away from each other by first segment 110 and second segment 120.

The specification explicitly describes an alternative embodiment that has a similar configuration as the embodiments described above in the specification. All the features described between page 1 and page 21, line 18 of the specification can be used to show support for Claims 19-26 and 45-50.

Enablement Rejections – 35 U.S.C. §112, First Paragraph

On page 11 of the OA the Examiner argues that Claims 22 and 23 are not enabled. The Examiner is directed to MPEP §2164.04:

The Examiner **must** provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must** be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

The Examiner has failed to provide a reasonable basis required to establish the enablement rejections of Claims 22 and 23. For this reason alone, these rejections should be withdrawn. Furthermore, as shown above, the specification contains sufficient teaching of the manner and process of making and using the inventions of Claims 22 and 23. Accordingly, Claims 22 and 23 must be taken as being in compliance with the

enablement requirement.

Rejections under 35 U.S.C. §§ 102 and 103

Amended Claim 19 recites, in part:

when the second segment is in the contracted position the second segment is overlaid and external to the first segment;

Claim 19 requires the second segment to be overlaid and external to the first segment when the second segment is in the contracted position. Lipponen describes a keyboard that is pushed into a housing element. The Examiner is directed to column 5, lines 23-25:

However, when the keyboard element is drawn out, the need for activation areas is smaller, and thus more room remains for the display area than when the keyboard element 3 is pushed into the body housing element 2.

Applicant respectfully submits that because the keyboard of Lipponen is pushed into a housing element, Lipponen does not disclose or suggest, among other things, the above-quoted limitations of Claim 19.

Kulp does not remedy the deficiencies of Lipponen. Kulp at most discloses a cursor control device. However, Kulp does not disclose or suggest, among other things, the above-quoted limitations of Claim 19.

Accordingly, the cited references, whether alone or in combination, do not disclose or suggest every limitation of Claim 19. Claim 19 is therefore not anticipated or rendered obvious by the cited references. Amended Claim 45 is patentably distinguishable over the cited references for at least the same reasons as Claim 19. Claims 20-26 and 46-50 incorporate the limitations of Claims 19 or 45, and are therefore patentably distinguishable over the cited references for at least the same reasons as their base claims.

Support for Amendments

The amendment to Claims 19 and 45 is supported throughout the specification, including, for example, at page 14, lines 11-18, page 15, lines 19-23, page 17, lines 13-23 page 21, lines 19-22 and FIGS. 8, 9 and 13.

The amendment to the drawings and the specification is supported throughout the specification, including, for example, at page 21, lines 19-22 and the various different portions of the specification discussed above for the written description rejections.

CONCLUSION

A Notice of Allowance is respectfully requested. If there are any questions or comments that the Examiner wishes to direct to Applicant's attorney, the Examiner is invited to call Applicant's attorney at (408) 551-6632.

If an extension of time is required in connection herewith, applicant hereby petitions for such extension.

Applicant hereby authorizes deposit account 501914 to be charged for any fee due in connection with this submission, including any extension of time fee.

Respectfully submitted,

MAHAMEDI PARADISE KREISMAN LLP

Date: _____

Van Mahamed, Reg. No. 42,828
Tel. 408-551-6632

MAHAMEDI PARADISE KREISMAN LLP
4880 Stevens Creek Blvd., Suite 201
San Jose, CA 95129-1034
Tel. 408-551-6632 Fax. 408-236-6641